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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,715	09/30/2003	Sidney Hornby	NEU-5012	4536
27777 7590 02/07/2008 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT 1615	PAPER NUMBER
			MAIL DATE 02/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/674,715	Applicant(s) HORNBY ET AL.	
	Examiner JYOTHSNA A. VENKAT Ph. D	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/16/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment, IDS and response filed on 11/16/07. Claims 15-21 have been canceled as per applicant's amendment dated 11/16/07. Claims 1-2, 4-7 and 11-14 are pending in the application and the status of the application is as follows:

Information Disclosure Statement

The information disclosure statement filed 11/16/07 has not been considered since applicants provided no date for the copy of the product label except for the statement on PTO-1449 that the products are publicly available before the invention date. The product labels do not have list of ingredients. The IDS is placed in the application file, but the information referred therein has not been considered.

Claim Rejections - 35 USC § 103

Claims 1-2, 4-7 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 4,999,187 ('187) and 5,843,193 ('193).

Instant application is claiming a product using combination of three conditioning agents drawn to oils and the product has advertising stating that the three conditioning agents condition different parts of the hair.

Patent '187 teaches hair treatment compositions using olive oil and almond oil. Oils are known conditioning agents since they provide emolliency to the hair/scalp. See the abstract. Patent at col.1, ll 49-55, col.2, ll 15-30 teaches olive oil and almond oil for scalp. See also claims 1-3. The difference between the patent and the instant application is patent does not disclose meadow foam seed oil as the third conditioning agent. However patent '193 teaches hair dye compositions and also teaches using meadow foam seed oil. Patent at col.11, ll 40-54 teaches

preferred compositions using fatty oil and the preferred oil is meadow foam seed oil. When dyeing compositions are applied to hair the dyes damage hair and therefore dyeing compositions also has oils to condition the hair. See example 1 and see claims 16-17. Regarding advertisement stating that the three oils condition different parts of the hair this does not carry any patentable weight since it is a marketing gimmick to attract the consumer.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '187 and add meadow foam seed oil taught by patent '193 as the preferred oil in analogous hair compositions. One of ordinary skill in the hair care art would be motivated to add meadow foam seed oil with the reasonable expectation of success that combination of more oils provide better conditioning effect to the hair. Regarding each oil conditioning different parts of region, since the oils claimed are same to that taught by both the patents the oils will also condition different parts of the hair claimed in the instant application since the compound and its property are inseparable. This is a prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 11/16/07 have been fully considered but they are not persuasive.

Applicant's argue:

"Applicants disagree. First, the references and the claimed invention relate to three different product classes. To wit, the claimed invention is a hair conditioner.

Vernon relates to a hair treatment composition for treating dandruff and growing hair,

although it may condition. The Hawkins et al. patent relates to a hair dye. Nothing is said in Hawkins et al. about conditioning”.

In response, claims are drawn to product comprising a composition for conditioning the hair and the composition comprising three ingredients, which are oils. Oils are known conditioning agents. Therefore one of ordinary skill in the hair care art would prepare another composition using the oils of compositions of ‘187 and add meadow foam seed oil taught by patent ‘193 as the preferred oil in analogous hair compositions and the idea of combining the ingredients flows logically from the art since oils are used in the hair care art.

Applicant also argue:

“The claimed composition requires three conditioning agents with three functions: one that penetrates into the core of the hair, one that penetrates into the cortex of the hair but does not substantially penetrate into the core of the hair, and one that does not substantially penetrate into the cortex of the hair and this is explicit in the claims. It is the result of applicants' recognition that different hair conditioning agents chemically affect the hair differently, and that by combining three hair conditioning agents with three different functions, a new and superior hair conditioning composition results. Applicants do not dispute that various oils such as those used herein are known in the art. However, identification of their chemical behavior and deliberate combination of them based on such chemical behavior is not found in the prior art”.

In response that the prior art does not disclose claimed property of oils, prior art may not disclose the claimed property, but the property is inherent since the prior art discloses the same claimed oils. The compound in this case oil and its properties are inseparable.

See below for the teachings of the specification (pages 16-18) with respect to claimed property.

Example 8:

Various hair conditioning agents were tested for their ability to penetrate into human hair. Secondary ion mass spectrometry (SIMS) in combination with a time of flight (TOF) mass spectrometer was used to determine hair penetration. Time-Of-Flight Secondary Ion Mass Spectrometry (TOF-SIMS) makes use of the secondary ion mass spectra (of atomic species or low molecular weight fragments), which are formed when the sample surface (e.g., surface of hair fiber cross sections) is bombarded with a positively charged gallium ion beam. The positive and negative ion mass spectra of the sample were obtained by the time-of-flight method. See, e.g., Ruetsch, et al., J. Cosmet. Sci., 52, 169-184 (2001). The Gallium gun, which emits a pulsed primary ion beam (accelerating voltage of 25 kV), was used in the study.

Instrumentation	PHI TFS-2000 (Physical Electronics USA, Chanhassen, MN 55317)
Primary ion beam	$^{69}\text{Ga}^+$ liquid metal ion beam (bunched)
Primary beam voltage	18 kV $^+$ ions, 12 kV $^-$ ions
Primary ion current (DC)	600 pA
Nominal analysis region	$(120\text{ }\mu\text{m})^2$, $(180\text{ }\mu\text{m})^2$

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Charge neutralization	yes
Post acceleration	8000 V
Masses blanked	None
Energy filter	No
Contrast diaphragm	No

The protocol was as follows. Dark brown European hair obtained from DeMeo Brothers, New York, NY was bleached for 30 minutes with alkaline 6% hydrogen peroxide (adjusted to pH 10.2 with ammonium hydroxide). The following hair conditioning agents used for the study: olive oil (Cropure® Olive #OL2-193E, Croda Inc., Parsipanny, NJ), almond oil (Cropure® Almond #AO2-196, Lipo Chemicals, Paterson, NJ); avocado oil (Cropure® Avocado #AV2-187, Croda Inc.); Meadowfoam Seed Oil (Botagenics, Inc., Northridge, CA); PEG-7 Oliviate (B&T SRL Biologia & Tecnologia, Milan, Italy); Sweet Almond Milk (containing Almond Proteins) (Mandor Lat, Sinerga, Rue dela Procession, France), Ceramide A2 (containing PEG-8/SMDI Copolymer and Palmitoyl Myristyl Serinate; from Sederma, Parsipanny, NJ); Sunflower Oil (Desert Whale Jojoba Co, Tucson, AZ), and Jojoba Oil (Desert Whale Jojoba Co.).

Nine small bundles of bleached hair fibers were treated by gently massaging the hair with one of the above nine hair conditioning agents and allowing the hair to rest on a hair slide for 24 hours at approximately 32°C. The treatments were followed by thorough 1 minute rinsing in very warm running water, while stroking the small hair bundle with a gloved hand in the with-scale direction, followed by air-drying at room temperature. This was done to remove extraneous

oils from the fiber surface. Bleached hair fibers (serving as controls) were rinsed well, blotted, and dried at room temperature.

Therefore the specification teaches that the hair fibers were treated by gently massaging the hair with one of the hair conditioning agents. There is no teaching in the specification that hair fibers were treated with all the three conditioning agents (composition claimed) and they were tested for their ability to penetrate the hair.

In view of the above reasons, the claims are obvious within the meaning of 35 U. S. C. 103 over the combination of patents since the patents teach the same claimed oils and the oils would therefore exhibit the claimed function.

Double Patenting

Claims 1-2, 4-7 and 11-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 4-8 of copending Application No. 10/675,868. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is claiming compositions for hair using the same three conditioning agents and the product comprising advertisement statement is obvious since it is a marketing gimmick to attract the consumer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This rejection is maintained. Applicant's intention of filing terminal disclaimer at the time of allowance is noted.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A. VENKAT/ Ph. D
Primary Examiner
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